

REMARKS

Claims 1-10 are pending in the above-referenced application. Claims 1-10 are rejected. In the detailed action, the Office Action has:

1. Indicated that the date of the invention is the filing date of the application Nov. 12, 2001;
2. Indicated that the Oath or Declaration was not executed in accordance with 37 CFR 1.66, and 1.68, but gives no reason in support of this allegation;
3. Indicated that claim 1 is indefinite under Section 112 due to the use of the phrases "sufficient to select" and "seller specific;"
4. Rejected claims 1-5, 7, 9, and 10 under 35 USC 103(a) as being unpatentable over Auctiva in view of Fredlund (US Pub. 2003/0058457); and
5. Rejected claims 6 and 8 under 35 USC 103(a) as being unpatentable over Auctiva in view of Fredlund and further in view of Official Notice.

Item 1

Regarding Item 1, Applicant points out that the effective date for any subject matter common to the present application and the prior filed applications to which benefit is claimed is at least the filing date of those prior filed applications. Only new subject matter has the invention date of the present application. The Office Action has also admitted on page 3 of the action that the earlier parent application 09/725,356 has effective filing dates of provisional filings 60/219,596 and 60/230,375, which are July, 20 2000 and September 6, 2000, respectively. Therefore, subject matter common to the parent and the current CIP has these effective filing dates. Because these effective dates of the parent application precede the dates of the Auctiva references, those references cannot be used in a combination to provide elements of the claims that are supported in the parent application. In effect, the Examiner is using Applicant's invention in the parent application against the Applicant. Applicant objects to the use of these references. Applicant reserves the right to swear behind the references if needed.

Item 2

Regarding Item 2, the Office Action has not given the reason for objecting to the declaration. If the Examiner is objecting to the title of the invention recited in the declaration, Applicant agrees that the

title is not that of the present application. However, the declaration refers to the serial number of the present application. Applicant will submit a correction to the title of the declaration if needed.

Item 3

Regarding Item 3, Applicant submits amended claims in this response to meet the objections.

Item 4

Regarding Item 4, and assuming *arguendo* that the Auctiva references are usable references under 103(a), the Office Action has alleged that the combination of the Auctiva references and Fredlund teaches or suggests the present invention as recited in claims 1-5, 7, 9, and 10. In particular, the Office Action has stated that the Auctiva references do not teach that the items are in a movable display, but that the Fredlund reference provides this teaching, citing FIG. 7 of Fredlund. Applicant respectfully submits that the proposed combination does not meet the limitations of claim 1 and no valid reason has been given for person of skill in the art to have made such a combination.

The proposed combination fails to meet the limitations of claim 1

The proposed combination fails to teach or suggest the limitation “to moveably display, in the item document on the client browser, a set of selectable images, showing the selected seller’s auction items,” recited in claim 1, because neither the Auctiva references nor the Fredlund reference teaches or suggests any such limitation.

None of the Auctiva1-5 references discloses the stated limitation. The Auctiva1, Auctiva2, Auctiva3 references describe a gallery of thumbnail images, item descriptions and current prices. The Auctiva4 reference describes a virtual storefront designed to help sellers brand themselves. The Auctiva5 reference describes ePoster, eBud products, and eBuyer products. According to the reference ePoster product permits a seller to add counters and pictures to a listing. The eBud product permits the seller to track current auctions, send emails and invoices. The eBuyer product permits the buyer to monitor items and categories on an auction site.

The Fredlund reference does not disclose the stated limitation. The Fredlund reference describes a method of providing efficient transfer of pictures from a remote location to a service provider. ‘457, paragraph 21. In particular, Fredlund describes the process of modifying pictures according to a set of user selectable criteria so that the pictures can be used on image bearing products, such as mugs, t-shirts, albums and standard prints. Id at paragraph 29, 33. According to Fredlund, in figure 7 a display screen includes a 2-dimensional array of thumbnail images of images to be used to create the image bearing product. Id at paragraph 40. Apparently, in Fredlund, the user can scroll the display screen to find an

image for selection. Id at paragraph 40. However, these features do not meet the cited limitation. The selectable images in the present invention are *moveably displayed in the item document* on the client browser. The images move without any user intervention, the speed of the motion being controllable by the position of a pointer relative to the center of the window in which the moving display is active. Specification, page 5. Therefore, the display screen in figure 7 of Fredlund clearly does not meet the limitation that is recited in claim 1.

Because neither the teachings of the Auctiva reference nor the Fredlund reference meets the cited limitation in claim 1, neither does the proposed combination.

A person of skill in the art would not have had a reason to make the proposed combination

The Office Action has alleged that it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the scrolling capability of the Fredlund reference with the teachings of Auctiva because this would permit the efficient viewing of a large number of items for sale, increase sales and make the site more user friendly. Applicant respectfully submits that neither reference supplies any reason to make the proposed combination. The Auctiva references do not contemplate any problem with providing a gallery of thumbnail images for user selection and the Fredlund reference is not concerned with promoting seller items at an auction site. Thus, a person of skill in the art who was aware of the Auctiva references would not have had any reason to look to Fredlund.

However, even if the person were to look to Fredlund, Fredlund would have only provided a way of letting the user scroll through a gallery of thumbnail images. This does not solve the problem that Applicant's invention does, which is to display a large number of seller-related images in a particular seller-item document so that the user does not have to navigate to a gallery of images. As described in Applicant's specification, page 1, this prevents the back and forth navigation problem present on the auction site. The Examiner has indicated that the motivation for making the combination would have been to "permit the efficient viewing of a large number of items for sale, increase sales and make the site more user friendly." However, this motivation is too general and not in the references. According to case law, the motivation to make a combination must be clear and particular; broad conclusory statements about the teaching of multiple references are not evidence.¹ Even the newly decided KSR case did not disturb this holding.² Because there is no rational underpinning to support the Office Action's conclusion, it appears

¹ Teleflex Inc. v. Ficosa North Am. Corp. 299 F.3d 1313, 63 USPQ2d 1374, 1387 (Fed. Cir. 2002)

that the proposed combination is the product of hindsight, impermissibly using Applicant's invention as a blueprint.³ Therefore, a person of skill in the art would not have made the proposed combination.

Regarding claim 2, the Office Action has alleged that claim 2 is unpatentable under 103(a) due to the proposed combination. Applicant submits that claim 2 is patentable at least because claim 1 from which it depends is patentable. Additionally, the proposed combination fails to teach or suggest the limitation "receiving the request from an auction item document obtained from an auction site," recited in claim 2. The proposed combination appears to be silent as to the presence of any requests from an auction item document.

Regarding claim 3, the Office Action has alleged that claim 3 is unpatentable under 103(a) due to the proposed combination. Applicant submits that claim 3 is patentable at least because claim 1 from which it depends is patentable.

Regarding claim 4, the Office Action has alleged that claim 4 is unpatentable under 103(a) due to the proposed combination. Applicant submits that claim 4 is patentable at least because claim 1 from which it depends is patentable. Additionally, the proposed combination fails to teach or suggest the limitation "wherein the picture displaying module is configured to moveably display the set of selectable images at a controllable speed; and wherein the controllable speed is controlled by a current position of a pointing device connected to the client computer system." The proposed combination mentions nothing about a picture displaying module, nothing about the speed at which the selectable images are displayed, nor anything about controlling that speed. As explained above, the Fredlund reference only refers to the manual scrolling of thumbnail images. Instead, in Applicant's invention, the images move automatically. No manual intervention is needed to move the images. Manual input is optionally used to control the speed of the moving selectable images. Therefore, the proposed combination fails to teach or suggest the limitations of claim 4.

Regarding the rejection of claim 5, Applicant submits claim 5 is patentable over the combination at least because claim 1, from which it depends is patentable over the combination. Additionally, the proposed combination fails to teach or suggest the limitation "wherein the picture displaying module is configured to moveably display the set of selectable images horizontally in the client browser graphical

² KSR v. Teleflex "To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")."

³ *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593, 1602 n.29 (Fed. Cir. 1987)

window,” recited in claim 5. Nothing in the proposed combination mentions a moving display of a set of selectable images horizontally in the client browser graphical window. Therefore, the proposed combination fails to teach or suggest the limitations of claim 6.

Item 5

Regarding Item 5, in which the Office Action has rejected claims 6 and 8 as being unpatentable under 103(a) over the Auctiva references in view of Fredlund, and further in view of Official Notice, Applicant submits that claim 6 is patentable over the proposed combination at least because claim 1 from which it depends is patentable over the combination. Additionally, the proposed combination fails to teach or suggest the limitations “wherein the main program is configured to load and activate a categories module that maintains a set of categories available on the auction site from the specified seller, said categories module initially obtaining the set of categories of the specified seller from the auction site and thereafter obtaining the set of categories from the auxiliary server.” Nothing in the proposed combination mentions anything about providing categories for items available for auction from a specified seller. The Office Action has cited the Auctiva3 reference to support the rejection, however, there is no mention of a categories list or actuating links in the Auctiva3 reference. The Auctiva2 reference describes a dynamic catalog which displays a seller’s listings from all of their on-line sales sites. According to that reference, by clicking an individual item listing, interested shoppers are taken to a gallery that includes all of a merchant’s current on-line offerings. This, however, does not describe the limitations of claim 6. The present invention does not take a potential bidder to a display that is different from the item page, but instead movably displays a seller’s items in the item page. Furthermore, the present invention categorizes the seller’s items. The Auctiva2 reference does not suggest or mention that there is any categorization of items, such as the items in the gallery. Therefore, the proposed combination of the Auctiva2 reference and Fredlund fails to teach or suggest the limitations of claim 6. Realizing this, the Office Action then takes Official Notice that providing selectable categories for limiting items from a large sample of products was old and well known in the art at the time of the invention. Applicant disagrees both with this characterization of the claim limitation and with its content. Furthermore, Applicant disagrees with this use of Official Notice.

The characterization of the limitation “wherein the main program is configured to load and activate a categories module that maintains a set of categories available on the auction site from the specified seller,” recited in claim 6 is too generic. Applicant is claiming the maintenance of a set of categories of seller’s items. The Office Action re-phrases this limitation as “categories provided from the seller match the categories that were assigned to the seller’s items at the auction site.” This re-phrasing is

inaccurate at least because it states that categories are provided from the seller or that categories are assigned to seller's items. Applicant's claim has no such limitations. Applicant requests that the Office Action be based on Applicant's actual claim limitations.

Applicant disagrees that the recited limitation was well-known in the art at the time of the invention. If such a feature were so well-known, then the auction site would have implemented it or the Auctiva references would have mentioned it. Neither do. Applicant submits that re-characterizing Applicant's limitation has led to the assertion of facts by Official Notice and that when the limitation is properly considered it cannot be considered to be well-known.

Finally, Applicant disagrees with the use of Official Notice. According to *In re Albert*⁴, the facts subject to Official Notice must be capable of such instant and unquestionable demonstration as to defy dispute. First, it is not clear that categories, according to the Office Action, limit items from a large sample of products. Categories may instead provide a way of organizing a large sample of products without limiting them. Second, the "use of categories" as the Office Action states it, for a seller's items is not indisputable. Apparently, the Auctiva showcase does not see any need to categorize the items in its gallery. Therefore, the facts subject to Official Notice are not such as to defy dispute and the Examiner must provide documentary evidence or an affidavit of the facts of which Official Notice was taken. *In re Zurko*, 258 F.3d at 1386.

Moreover, the Office Action has alleged that one of skill in the art would have used categories specified in the initial posting when posting the item to the auction site, citing ePoster in the Auctiva⁵ reference. Applicant disagrees. The ePoster reference does not teach anything with respect to categorizing a particular seller's items. Instead, it refers to a buyer setting up an arbitrary set of categories having nothing to do with a specific seller. Therefore, the cited support for "using categories," cited in the Office Action, fails to include any evidence to motivate the making of a combination that meets the limitations in claim 6. Applicant's claim does not simply refer to "using categories," but specifically, the categorizing of a particular seller's items and nothing in the cited references or the "Official Notice" teaches this limitation. Therefore, the proposed combination of the two references and "facts" from "Official Notice," does not meet the limitations of claim 6.

Regarding the rejection of claim 7, Applicant submits that claim 7 is patentable over the combination at least because claim 6, from which it depends is patentable over the combination. Additionally, the proposed combination fails to teach or suggest the limitation "wherein the set of

⁴ *In re Albert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970)

categories available on the auction site from the specified seller is stored on the auxiliary server,” because the proposed combination makes no mention of categories that relate to items available from a selected seller and certainly makes no suggestion as to where such category information is stored. Therefore, the proposed combination fails to teach or suggest the limitations of claim 7.

Regarding the rejection of claim 8, the Office action has alleged that the combination of the Auctiva references, Fredlund and the facts of the “Official Notice” renders claim 8 unpatentable over section 103(a). Applicant submits that claim 8 is patentable at least because claim 6, from which it depends, is allowable. Additionally, claim 8 is allowable because the proposed combination fails to teach or suggest the limitation “wherein the main program is configured to load and activate an item links module that maintains a set of item links for each category in the set of categories available on the auction site from the specified seller.” The proposed combination says nothing about categories for the available items of a specified seller and thus says nothing about a set of item links for each category in the set of categories available on the auction site from the specified seller. Even if somehow the Auctiva3 reference is interpreted to have item links, any such links are not specific to the items in a category. Therefore, there is nothing in the proposed combination that teaches or suggest the limitation of claim 8.

Regarding the rejection of claim 9, Applicant submits that claim 9 is patentable over the proposed combination at least because claim 8, from which it depends is patentable over the combination. Additionally, the proposed combination fails to teach or suggest the limitation “wherein the set of item links available on the auction site from the specified seller is stored on the auxiliary server.” Because the proposed combination says nothing about categories of items available on an auction site from a particular seller, it is also silent about where links to items in a category are stored.

Regarding the rejection of claim 10, Applicant submits that claim 10 is patentable over the proposed combination at least because claim 9 from which it depends is patentable.

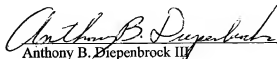
Conclusion

Claims 1,2 and 4-10 are believed to satisfy all of the criteria for patentability and are in condition for allowance. An early indication of the same is therefore kindly requested.

No fees beyond the extension of time fees are believed to be due in connection with this Amendment. However, the Director is authorized to charge any additional fees that may required, or credit any overpayment, to Dechert LLP Deposit Account No. 50-2778 (Order No. 372499-00102 (336988)).

Respectfully submitted,

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